

REMARKS

Claims 1-17 are pending in this application. Claims 1-3, 5, 6, 8, 9 and 11-17 stand rejected and claims 4 and 10 are objected to. Applicant wishes to thank the Examiner for the indication of allowance of claim 7, and the indication of allowable subject matter in claims 4 and 10. Claim 11 has been amended to correct a spelling error. In light of the remarks set forth below, Applicant respectfully submits that each of the pending claims is in immediate condition for allowance.

Applicant acknowledges with appreciation the Examiner's allowance of claim 7 and the indication of allowable subject matter in dependent claims 4 and 10. For the reasons set forth below, Applicant submits that claims 1-3, 5, 6, 8, 9 and 11-17 are also patentable over the prior art of record.

Paragraph 2 of the Office Action rejects claims 1-3, 8, 9 and 14-17 under 35 U.S.C. § 103(a) over JP 6-132837 ("Oki") in view of U.S. Patent No. 5,606,741 ("Yamamoto"). Applicant requests reconsideration and withdrawal of this rejection.

Simply because information is well known does not make it obvious to combine that information with any reference. The Office Action must explain the reasons why one of ordinary skill in the art would be motivated to select the references or teachings and combine them. In re Rouffet, 47 U.S.P.Q.2d 1453, 1459 (Fed. Cir. 1998). A principle must be identified, known by those with ordinary skill in the art, that suggests the claimed invention. Id. Inventions are frequently the process of combining prior art in a nonobvious manner. Id.

To properly reject the Applicant's claims for obviousness in view of a combination of prior art references, the Office Action must establish that a person of ordinary skill in the art would have been motivated to combine the cited references and, in

combining them, would have arrived at the invention claimed by the Applicant. In re Kotzab, 208 F.3d 1365, 1370 (Fed. Cir. 2000). A motivation to combine may arise from: (i) either explicit or implicit statements in the prior art references themselves; (ii) the knowledge of those of ordinary skill in the art that certain references, or disclosures in those references, are of special interest or importance in the field; or (iii) the nature of the problem to be solved. Ruiz v. A.B. Chance Co., 234 F.3d 654, 665 (Fed. Cir. 2000).

Regardless of its source, or the form that it takes, a motivation to combine must be clearly and particularly shown. In re Dembiczak, 175 F.3d 994, 999-1000 (Fed. Cir. 1999). The Federal Circuit has held that a motivation to combine is not shown by the mere assertion that the claimed invention would have been obvious to one of ordinary skill in the art simply because it is a combination of elements that were known at the time of the invention:

[T]here is no basis for concluding that an invention would have been obvious solely because it is a combination of elements that were known in the art at the time of the invention. See Fromson v. Advance Offset Plate, Inc., 755 F.2d 1549, 1556, 225 U.S.P.Q. 26, 31 (Fed.Cir.1985). Instead, the relevant inquiry is whether there is a reason, suggestion, or motivation in the prior art that would lead one of ordinary skill in the art to combine the references, and that would also suggest a reasonable likelihood of success. See, e.g., In re Dow Chem. Co., 837 F.2d 469, 473, 5 USPQ2d 1529, 1531-32 (Fed.Cir.1988).

Smiths Indus. Medical Systems Inc. v. Vital Signs, Inc., 183 F.3d 1347, 1356 (Fed. Cir. 1999); see also In re Dembiczak, 175 F.3d at 999-1000 (Fed. Cir. 1999).

The Office Action's sole justification for combining Oki and Yamamoto is precisely the sort of assertion that the Federal Circuit rejected in Smith. The Office Action argues that one of skill in the art would have combined Oki and Yamamoto, because one

“it would have been obvious for an ordinary person skilled in the art at the time of the invention to include transceiver as taught by Yamamoto with the apparatus and method of Oki.” See Office Action, at 3. This assertion, however, is merely conclusory. The simple statement that the arrangement of components disclosed by Oki is well-known in the art does not say how or why a person of ordinary skill in the art would be motivated to modify the arrangement of components of Oki in light of Yamamoto.

Further, Yamamoto’s field intensity detecting circuit 9-3 is unlike that disclosed and claimed by Applicant. Yamamoto’s field intensity detecting circuit uses a longer period (lower frequency) as field intensity increases in contrast to Applicants field intensity detecting circuit wherein the frequency becomes smaller as the electric field strength becomes smaller. Thus, one would not seek to combine these circuits simply because they both have field intensity detecting circuitry.

In addition, the Office Action argues that a motivation to combine Oki and Yamamoto exists because “The motivation would be to be able to transmit and receive while reducing error and interference.” See Office Action, at 3. Here, the Office Action only asserts that the components in Yamamoto can be arranged in the manner disclosed in Oki. It does not show why one of ordinary skill in the art would be motivated to actually do so. That is to say, the Office Action does not explain why a person of skill in the art would not have been motivated to rearrange the components of Yamamoto to reflect the arrangement shown in Oki, rather than the other way around.

The Office Action’s assertions are general and conclusory. Simply asserting that what is taught in Oki is well-known to one of skill in the art, without more, does not provide the Applicant with a sufficiently clear and particular showing of a motivation to combine.

In summary, the Office Action fails to establish with clarity and particularity that a person of ordinary skill in the art would be motivated to change the arrangement of components disclosed in Oki in light of Yamamoto. As a result, the Applicant respectfully submits that the Office Action fails to establish a *prima facie* case of obviousness with respect to claims 1-3, 8, 9 and 14-17, and that the objection to those claims under Section 103 should be withdrawn.

Paragraph 3 of the Office Action rejects claims 5-6, and 11-13 under 35 U.S.C. § 103(a) over Oki in view of Yamamoto further in view of U.S. Patent No. 5,390,340 ("Kondo"). Applicant requests reconsideration and withdrawal of this rejection.

Kondo was not cited to cure the deficiency in the combination of Oki and Yamamoto discussed above, and indeed it does not. Rather, Kondo allegedly discloses certain additional features recited by claims 5, 6, 11 through 13. Regardless of whether or not Kondo recites these additional features, the combination of Oki, Yamamoto and Kondo remains deficient, and does not disclose or suggest each and every limitation of claims 5, 6, 11, and 12. As a result, the rejection of these claims under 35 U.S.C. 103(a) should be withdrawn.

Applicant has responded to all of the rejections and objections recited in the Office reconsideration and Notice of Allowance for all of the pending claims is therefore respectfully requested.

The amendments to the claims are for clarification purposes only and are not intended to limit the scope of the claims in any way. It is asserted that the present amendment places the application in a form for allowance. Entry of this amendment is therefore earnestly solicited.

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If the Examiner believes an interview would be of assistance, the Examiner is welcome to contact the undersigned at the number listed below.

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Respectfully submitted,

By 

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